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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,858	10/27/2003	Hideyuki Kakuwa	031242	9233

21874                      7590                      03/05/2009  
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EXAMINER
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LE, LINH GIANG

ART UNIT	PAPER NUMBER
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3686

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03/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,858	<b>Applicant(s)</b> KAKUWA ET AL.	
	<b>Examiner</b> MICHELLE LE	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 27 October 2003.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-16 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 27 October 2003 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>102703</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to application filed 27 October 2003. It is noted that application claims foreign priority to 2002/314951 filed 29 October 2002. Claims 1-16 remain pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

As per claims 1-8 and 11- 14, it is unclear as to which recognized statutory class of invention the "insurance warranty system" is directed. In particular, a "warranty" is not a process or method, as it lacks a series of steps. An insurance warranty is not a machine or system, as there is no specific recitation of machine or system components. An insurance warranty is not recognized as a composition of matter. An " insurance warranty" may not be considered an article

Art Unit: 3686

of manufacture since the term "warranty" describes a collection of the financial, legal, or administrative rights and obligations of the parties involved.

Claims 9-10, 15-16 are rejected under 35 USC 101 as these claims are directed to non-statutory subject matter. A claimed process is patent eligible under 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing. Independent claims 9, 10, 15 and 16 are directed towards an insurance warranty method. There is no tie to a particular machine or apparatus in the body of the claim nor is there a transformation of a particular article towards a different state or thing. Thus the claims are directed towards a patent-ineligible process under 35 USC 101. Furthermore, a nominal recitation in the preamble of structure in an otherwise ineligible method fails to make the process statutory.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3686

5. The claim(s) are narrative in form and replete with indefinite and functional or operational language. If the Applicant intends to recite an apparatus or article of manufacture, the structures that make up the device or article of manufacture must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

6. Furthermore, method claims directed towards an insurance warranty do not set forth any steps involved in a method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon (7,421,406).

Art Unit: 3686

9. As per claim 1, Dixon teaches an insured warranty system for performing processing by using a computer, wherein:

a part or all of insurance premiums paid to a guaranty institution by a client who got a loan from a financial institution is paid to a nonlife insurance institution by said guaranty institution as insurance money (Dixon; Col. 5, line 61 to Col. 6, line 25);

when said client becomes unable to work during a first period, a monthly repayment amount by the client to the financial institution during the period of being unable to work is paid by said nonlife insurance institution as insurance money in accordance with a period obtained by subtracting an exceptional period from the actual period of being unable to work (Dixon; Col. 5, line 61 to Col. 6, line 25);

Dixon does not expressly teach when said client are unable to work for more than upper limit months of said first period, said guaranty institution pays as guarantee a remaining repayment amount until the end of the period of being unable to work after exceeding the upper limit months of said first period, besides said payments by the nonlife insurance institution. However, this feature is an obvious variant of the Dixon teachings. Dixon teaches an expanded set of savings and risk management services using a variety of financial instruments (Dixon; Col. 6, lines 9-41). One of ordinary skill in the art would have been motivated to modify the Dixon teachings in order to provide *additional* benefits and protection to the basic coverage for events such as unemployment (Dixon; Col. 6, lines 9-41).

Art Unit: 3686

As per claim 2, Dixon teaches insured warranty system for performing processing by using a computer, wherein:

a part or all of mutual aid premiums paid to a mutual aid institution by a client who got a loan from a financial institution is paid to a guaranty institution as guarantee and to a nonlife insurance institution as insurance money by said mutual aid institution (Dixon; Col. 5, line 61 to Col. 6, line 25);

when said client becomes unable to work during a first period, a monthly repayment amount by the client to the financial institution during the period of being unable to work is paid by said nonlife insurance institution as insurance money in accordance with a period obtained by subtracting an exceptional period from the actual period of being unable to work (Dixon; Col. 5, line 61 to Col. 6, line 25);

Dixon does not expressly teach when said client is unable to work for more than upper limit months of said first period, said guaranty institution pays as guarantee a remaining repayment amount until the end of the period of being unable to work after exceeding the upper limit months of said first period, besides said payments by the nonlife insurance institution. However, this feature is an obvious variant of the Dixon teachings. Dixon teaches an expanded set of savings and risk management services using a variety of financial instruments (Dixon; Col. 6, lines 9-41). One of ordinary skill in the art would have been motivated to modify the Dixon teachings in order to provide *additional* benefits

Art Unit: 3686

and protection to the basic coverage for events such as unemployment (Dixon; Col. 6, lines 9-41).

10. As per claims 3-8, Dixon does not expressly teach:

wherein said first period is more than one month and not more than seven months after a payment of guaranty premiums or mutual aid premiums is made by said 25 client;

wherein said exceptional period is one month.

wherein an upper limit of an amount paid by said nonlife insurance institution as insurance money is an amount of six months of monthly repayments by the client to the financial institution.

wherein said first period is more than 7 days and not more than 372 days (12 months plus 7 days) after a payment of guaranty premiums or mutual aid premiums is made by said client.

wherein said exceptional period is seven days.

wherein an upper limit of an amount paid by said nonlife insurance institution as insurance money is an amount of twelve months of monthly repayments by the client to the financial institution.

However, Examiner submits these are obvious variants of the Dixon teachings. In particular, Dixon teaches a customized risk management program for the customer (Dixon; Col. 7, lines 4-20). Thus one of ordinary skill in the art would interpret a customized risk management program to have various different monthly time limits to satisfy a company and a customer's needs. One of



Art Unit: 3686

ordinary skill in the art would have been motivated to modify the Dixon teachings in order to provide benefits and protection to the basic coverage for events such as unemployment (Dixon; Col. 6, lines 9-41).

11. Claims 9 and 10 repeat substantially similar limitations of claims 1 and 2 and the reasons for rejection are incorporated herein.

12. As per claim 11, Dixon teaches an insured warranty system for performing processing by using a computer, wherein:

a part or all of mutual aid premiums paid to a mutual aid institution by a client who got a loan from a financial institution is paid to an insurance institution by said mutual aid institution (Dixon; Col. 5, line 61 to Col. 6, line 25); and during a first period, when said client

(i) goes into voluntary bankruptcy, a remaining principal amount by the client to the financial institution after that is paid by said insurance institution in a range of up to a limit amount set in advance (Dixon; Col. 6, lines 9-41);

(ii) dies, and when the limit amount is not more than a remaining principal amount as a result of comparing the remaining principal amount by the client to the financial institution with the limit amount set in advance, the limit amount is paid by said insurance institution, while when the limit amount exceeds the remaining principal amount, the limit amount and a balance obtained by subtracting the remaining principal amount from the limit amount are paid by said insurance institution advance (Dixon; Col. 6, lines 9-41); and

Art Unit: 3686

(iii) gets hospitalized or encounters a disaster on house, an amount of one month of monthly repayment by the client to the financial institution is paid by said insurance institution advance (Dixon; Col. 6, lines 9-41).

Dixon does not expressly teach specific time and dollar amounts. However, Examiner submits these are obvious variants of the Dixon teachings. In particular, Dixon teaches a customized risk management program for the customer (Dixon; Col. 7, lines 4-20). Thus one of ordinary skill in the art would interpret a customized risk management program to have various different monthly time limits to satisfy a company and a customer's needs. One of ordinary skill in the art would have been motivated to modify the Dixon teachings in order to provide benefits and protection to the basic coverage for events such as unemployment (Dixon; Col. 6, lines 9-41).

13. Claims 12-16 repeat substantially the same limitations or are obvious variants of the teachings in claim 11. Thus, the reasons for rejection are incorporated herein.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571)272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on 571-272-3600. The

Art Unit: 3686

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/15/09

/M. L./

Examiner, Art Unit 3686

/C. LUKE GILLIGAN/

Supervisory Patent Examiner, Art Unit